

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : **10/731,933**
Inventor : **Rasidescu, Mihai et al.**
Title : **"Methodology for the Design and Manufacture of a Family of Recreational Vehicles and the Vehicles Designed and Manufactured According to that Methodology"**
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Art Unit : **3618**
Examiner : **WALTERS, John Daniel**
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-4 and 8-15 are currently pending in the application.

In regard to Rejection of Claims 1-4 and 10-13 Under 35 USC § 103(a)

The Examiner has rejected claims 1-4 and 10-13 under 35 U.S.C. § 103(a), as being unpatentable over Laimböck, U.S. Patent No. 6,467,562, in view of Pestotnik, U.S. Patent No. 6,182,784. The Applicants respectfully disagree.

Independent claims 1 and 10 are reproduced here for convenience. Claim 1 recites

1. A vehicle selected from a family of vehicles, the family comprising:
 - a first land vehicle of a first vehicle type selected from a group of vehicle types consisting of a motorcycle, a snowmobile, and an all terrain vehicle, the first land vehicle having a first V-type engine having a configuration, and a first transmission operatively connected

thereto,

- a second land vehicle of a second vehicle type selected from the group of vehicle types, the second land vehicle comprising the having a second V-type engine of the same configuration as the first V-type engine, and a second transmission operatively connected thereto,
- the second vehicle type being any vehicle type from the group of vehicle types other than the first vehicle type, and
- the first and second transmissions being separate components from the respective engines.

For its part, claim 10 recites

10. A vehicle selected from a family of vehicles, the family comprising:

- a land vehicle selected from a group consisting of a motorcycle, a snowmobile, and an all terrain vehicle, the land vehicle comprising a first V-type engine having a configuration, and a transmission operatively connected thereto; and
- a water vehicle selected from a group consisting of a personal watercraft having an engine, a boat having an inboard engine, and a boat having an outboard engine, the engine of the water vehicle being a second V-type engine of the same configuration as the first V-type engine.

The Examiner has stated on page 4 of his final rejection dated June 14, 2006 that

[w]ithin the independent claims, i.e. claims 1 and 10, no requirement is present for TWO vehicles to be disclosed. These claims recite “**A vehicle** selected from a family of vehicles...” (emphasis mine)

Therefore, if one member of said family is disclosed, the requirement is met. Additionally, Applicant states specifically within the remarks filed 6 June 2006, “What is claimed is a single vehicle...” (page 9, final paragraph).

That being the case, the motorcycle of Laimböck fits within the family as recited in claims 1 and 10 and satisfies the limitations of said claims.

The Examiner has reiterated in his advisory action dated August 23, 2006 that

[i]t is the position of the Office that Applicant’s claims, as currently written, require one vehicle containing the stated limitations. As one vehicle has been shown within the prior art, the claims are properly rejected.

The Applicants believe that the Examiner has misunderstood the claims, as well as the Applicants' remarks in the communications filed on June 6, 2006 and August 14, 2006.

The Applicants did state that what is claimed is a single vehicle. However, a single vehicle taught by the prior art must still satisfy all of the features recited in the claim in order to render the claim unpatentable. The Applicants submit that the prior art cited by the Examiner fails to teach all of the features of the claimed vehicle, in particular that it is selected from a family of vehicles defined in the claims as follows:

Claim 1 recites

a family of vehicles [...] comprising:
a first land vehicle of a first vehicle type [...], the first land vehicle having a first V-type engine having a configuration, [...]
a second land vehicle of a second vehicle type [...], the second land vehicle having a second V-type engine of the same configuration as the first V-type engine, [...]
the second vehicle type being any vehicle type from the group of vehicle types other the first vehicle type [...].

For its part, claim 10 recites

a family of vehicles [...] comprising:
a land vehicle [...], the land vehicle comprising a first V-type engine having a configuration, [...] and
a water vehicle [...], the engine of the water vehicle being a second V-type engine of the same configuration as the first V-type engine.

As the Applicants explained in the communications filed on June 6, 2006 and August 14, 2006, the vehicle of Laimböck cannot be a vehicle selected from a family as claimed unless there exists a family of vehicles, of which the vehicle of Laimböck is a member, that satisfies the properties recited in the claims. If such a family does not exist, the vehicle of Laimböck cannot be a vehicle selected from the family, and as such cannot render the claim unpatentable.

As the Applicants explained in the communications filed on June 6, 2006 and August 14, Laimböck teaches only one type of vehicle, namely a motorcycle. In order for the family of claim 1 or 10 to exist, a second vehicle of a second type must exist, having an engine of the same configuration as the engine in the vehicle of Laimböck. There is no teaching in the art to provide a second vehicle having this engine configuration, and the Examiner has not provided any motivation in the art to modify Laimböck to provide a second vehicle having this engine configuration. As such, the prior art does not teach a family as defined in claim 1 or 10 of which the vehicle of Laimböck is a member. By extension, the vehicle of Laimböck cannot be a vehicle selected from such a family.

The Applicants respectfully disagree with the Examiner's assertion that the disclosure of a single vehicle can satisfy the limitations of claims 1 and 10. It is impossible for Laimböck to disclose one member of a family unless the family is first shown to exist. The family defined in the claims requires the existence of at least two vehicles having the same engine configurations. As such, regardless of what single vehicle is disclosed by Laimböck, the Examiner must demonstrate the existence in the prior art of a family of vehicles as defined in claim 1 or 10, and he must then demonstrate that the single vehicle disclosed by Laimböck is a member of that family. If a family does not exist from which the vehicle of Laimböck can be selected, the vehicle of Laimböck cannot be a vehicle selected from that family and therefore cannot teach the features of either claim 1 or claim 10.

Therefore, Laimböck does not teach a vehicle selected from a family of vehicles as claimed.

As the Applicants explained in the communications filed on June 6, 2006 and August 14, 2006, Pestotnik fails to remedy this deficiency in Laimböck. Pestotnik teaches only an ATV, and therefore does not teach a family of vehicles comprising first and second vehicles of different types having engines of the same configuration. In addition, Pestotnik does not teach an ATV having an engine with the same configuration as the engine in the motorcycle of Laimböck. Therefore, even if Laimböck and Pestotnik could be combined, which is not admitted, their combination would not teach a family of vehicles comprising first and second vehicles of different types having engines with the same configuration, from which the single vehicle of Laimböck, or any other single vehicle, could be selected. By extension, the combination of Laimböck and Pestotnik fails to teach a vehicle of any type selected from such a family.

Therefore, for all the reasons set out herein above, at least one feature of claims 1 and 10 as amended is not taught by Laimböck or Pestotnik, alone or in combination, which combination is not admitted. As such, it is requested that the rejection of claim 1 and claims 2-4 depending therefrom, as well as claim 10 and claims 11-13 depending therefrom, be withdrawn.

In regard to Rejection of Claims 8, 9, 14 and 15 Under 35 USC § 103(a)

The Examiner has rejected claims 8, 9, 14 and 15 under 35 U.S.C. § 103(a), as being unpatentable over Laimböck in view of Pestotnik and further in view of Ducati Museum web page. The Applicants respectfully disagree.

As discussed above with respect to claims 1-7 and 10-13, the combination of Laimböck and Pestotnik, which combination is not admitted, fails to teach a vehicle selected from the family recited in either of claims 1 or 10.

This deficiency in Laimböck and Pestotnik is not remedied by the Ducati Museum web page, without admitting that the Ducati Museum web page can be combined with either or both of Laimböck and Pestotnik, and reserving the right to argue thereagainst in the future.

The Examiner relies on the Ducati Museum web page to teach particular aspects of engine configurations that he recognizes are not taught in either Laimböck or Pestotnik, namely a 750 cc, 90-degree V-type engine. As such, neither Laimböck nor Pestotnik teach a vehicle having an engine with the same configuration as the engine described on the Ducati Museum web page. Therefore, the combination of Laimböck, Pestotnik and the Ducati Museum web page, which combination is not admitted, does not teach a family of vehicles comprising first and second vehicles of different types having engines with the same configuration from which a vehicle could be selected, or a vehicle selected therefrom.

Therefore, at least one feature of claims 1 and 10 as amended is not taught by Laimböck, Pestotnik or the Ducati Museum web page, alone or in combination, which combination is not admitted. As such, it is requested that the rejection of claims 8 and 9 depending from claim 1, as well as claims 14 and 15 depending from claim 10, be withdrawn.

Respectfully submitted,

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